

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM F. PITTORE

Appeal No. 1999-0590
Application 08/444,841

ON BRIEF

Before KRASS, JERRY SMITH and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-42, which constitute all the claims in the application. An amendment after final rejection was filed on March 5, 1998 and was entered by the examiner.

The disclosed invention pertains to an information processing system having a visual display device. A processor runs application programs which display message boxes to the user when certain conditions occur in connection with the performance of the application program. The invention enables the user to copy the information from the message box into a buffer for a later review of the messages generated.

Representative claim 1 is reproduced as follows:

1. An information processing system comprising:
 - A. a visual display device for displaying information to an operator;
 - B. a common buffer;
 - C. an applications program processor for performing predetermined processing operations, the applications program processor detecting selected conditions in connection with its performance of the predetermined processing operations, providing a message text item in response to the detection of one of the selected conditions, and enabling generation of a message box therefor including the message text item and an actuable copy enable facility, said applications program processor enabling the message box to be displayed by the visual display device; and
 - D. a control subsystem for enabling (i) the message box generated by said applications program processor to be displayed by the visual display device and (ii) said message text item to be copied to the common buffer in response to actuation of said copy enable facility by an operator.

The examiner relies on the following references:

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Boulton et al. (Boulton) 5,566,291 Oct. 15, 1996
(effective filing date of Dec. 22,
1994)

Claims 1-42 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Boulton taken alone. Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-42. Accordingly, we reverse.

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Appellant has indicated that for purposes of this appeal no grouping of claims is made [brief, page 4]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art

as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could

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have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner cites Boulton as teaching an information processing system in which a user can elect to provide feedback to a common buffer during the course of using an application program for later review. The examiner recognizes that the feedback information in Boulton occurs at the request of the user rather than through the result of message boxes automatically displayed by an application program as recited in claim 1. Nevertheless, the examiner finds that it would have been obvious to the artisan to add this automatic feedback feature to the system of Boulton [answer, pages 3-4].

Appellant argues that Boulton makes use of a dialog box initiated by the user whereas the claimed invention recites a message box initiated by an application program. Appellant argues that there is no suggestion in Boulton that information should be stored in any manner other than upon request by the operator. Appellant additionally points out that any suggestion to modify Boulton as proposed by the examiner is speculative and based on hindsight use of

appellant's disclosure. The thrust of appellant's argument is that information stored in the claimed invention is determined by the applications program whereas information stored in Boulton is determined by the operator [brief, pages 4-11].

The examiner responds that the claimed invention would have been obvious to the artisan because the reviewer in Boulton would have been interested in knowing which message boxes were activated by the operator's use of the application program because it indicates some kind of problem the operator had while running the application program [answer, pages 5-8].

We agree with the position argued by appellant. The examiner admits that the only applied prior art reference does not teach the storage of message boxes automatically generated by an application program when predetermined conditions occur during the performance of the application program. Although the examiner has identified advantages to be obtained by modifying the reference to have this feature, the examiner has not identified where the applied reference suggests this modification. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the

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desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There is no suggestion within the applied prior art to make the modification proposed by the examiner. On this record, the only basis for making the examiner's proposed modification of Boulton would appear to be based on an improper attempt to reconstruct appellant's invention in hindsight.

Since the examiner's proposed modification of Boulton is not suggested by the prior art of this record, we do not sustain the examiner's rejection of the appealed claims. Therefore, the decision of the examiner rejecting claims 1-42 is reversed.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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PATENT	ERROL A. KRASS)) BOARD OF
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)	
	LANCE LEONARD BARRY))
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